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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,666

05/09/2006

Shigekazu Teranishi

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2768

25944 7590 09/15/2009

OLIFF & BERRIDGE, PLC

P.O. BOX 320850

ALEXANDRIA, VA 22320-4850

EXAMINER

NELSON, MICHAEL B

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

09/15/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,666	<b>Applicant(s)</b> TERANISHI ET AL.	
	<b>Examiner</b> MICHAEL B. NELSON	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendments filed on 07/20/09 and 07/06/09 have been entered. Claims 15-36 are currently under examination on the merits. The examiner notes that the applicant's arguments related to the implicit support in the specification for the exclusion of fluorinated alkyl groups from the embodiments which do not contain fluorinated alkyl groups (as compared to those that do contain them) is persuasive.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 15-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Yokoyama et al. (U.S. 6,440,572).

4. Regarding claims 15-36, Yokoyama et al. discloses a heat transfer recording film in which the inventive stick proof layer is provided on one side of a base film and ink is provided on the other side (C8, L25-67). The stick proof layer is made up of a polydimethylsiloxane (C2, L55-C7, L30) copolymer which includes alkyl groups (stearyl methacrylate C3, L50, is an example of the instant alkyl group according to page 6 of the instant specification). The alkyl group is included in the copolymer at 40% (C8, L1-10) and a second component (B) acts as a binder resin (C7, L10-40). The copolymer is disclosed as being made by either azo block or graft copolymerization processes (C2, L45-67). As the block azo group, Yokoyama et al.

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discloses the compound of claim 35 (C4, L55-65, chemical formula 4). As the graft compound, Yokoyama et al. discloses the compound of instant claim 36 (C3, L5-15, chemical formula 1). Stearyl acrylate (C3, L45) is disclosed as combined with the stearyl methacrylate (C3, L50) mentioned earlier (C4, L20-30). The silicon of the stick proof layer is only in the polydimethylsiloxane component.

### ***Response to Arguments***

5. Applicant's arguments filed on 07/20/09 and 07/06/09 are considered moot in light of the new grounds of rejection which were necessitated by applicant's amendments. Particularly, applicant's affidavit filed on 07/20/09 is considered moot since it addresses an issue with the previous prior art which is no longer relied upon. Arguments which are still deemed to be relevant are addressed below.

6. Regarding applicant's arguments related to the list of vinyl monomers in Yokoyama et al., the examiner does not agree. Firstly, applicant argues that the list of Yokoyama et al. is so exhaustive as to prohibit the obvious selection of the particular vinyl monomers that are claimed. The examiner does not agree that the list is sufficiently long to apply this argument because a relatively small amount of general candidate materials (i.e. acrylates, vinyl ethers, styrenes etc.) are listed and from each of these general groups, a relatively small list of subspecies is presented (stearyl methacrylate being a subspecies of the acrylate group). Therefore, the list does not present all of the species as equivalent, but rather presents a few groups as equivalents and then gives examples of species from each group.

Additionally, although Yokoyama et al. discloses the use of other types of vinyl monomers, applicant's attention is drawn to MPEP 2131.02 (A) which states that "...when the

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species is clearly named, the species claim is anticipated no matter how many other species are additionally named”. *Ex Parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990).

7. Secondly, applicant argues that the specific species that are instantly claimed have unexpectedly superior properties; however, the data provided is insufficient. One particular problem is that the compositions having the 12 carbon alkyl groups are not compared to the other components listed in Yokoyama et al. but rather are merely compare to compositions without the 12 carbon alkyl groups.

8. Lastly, the fact that the instant claims are rejected under 102(b) precludes the above reasoning from being applied to overcome the rejection: As cited in MPEP 706.02(b), it is noted that a rejection based on 35 USC 102(b), can only be overcome by (a) persuasively arguing that the claims are patentably distinguishable from the prior art, (b) amending the claims to patentably distinguish over the prior art, or (c) perfecting priority under 35 USC 119(e) or 120. As can be seen, comparative data is not sufficient to overcome an anticipatory rejection under 102(b).

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL B. NELSON whose telephone number is (571) 270-3877. The examiner can normally be reached on Monday through Thursday 6AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R. Sample/  
Supervisory Patent Examiner, Art Unit 1794

/MN/  
08/21/09